

REMARKS/ARGUMENTS

This paper is responsive to the Office Action mailed June 1, 2009. Claims 1, 2, 4, 6-14, 16-21 and 35 were pending before submission of this paper. Claims 1, 2, 4, 6-14, 16-21 and 35 stand rejected. Specifically, claims 1, 2, 4, 6-14, 16-21 and 35 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Claims 1, 2, 4, 6-21, and 35 continue to be rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 2, 4, and 6-8 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Calabria* (US 2005/0137939). Claims 9-14, 16-21 and 35 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Calabria* (US 2005/0137939) in view of *Harik* (US 2005/0065806). Applicants respectfully disagree. Claims 1, 9, 13-14, and 35, have been amended. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

I. Applicants' Formal Drawings

Applicants submitted formal drawings for Figures 1-11 on May 20, 2009. The Office Action did not acknowledge receipt of the drawings and/or whether the drawings are acceptable. Because the replacement drawings are available on PAIR and because no objection to the drawings has been made, Applicants assume that the replacement drawings are acceptable.

II. Claims 1, 2, 4, 6-14, 16-21, and 35 Comply with the Written Description Requirement of 35 U.S.C. § 112, First Paragraph

Claims 1, 2, 4, 6-14, 16-21, and 35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully disagree.

A. Independent Claim 1

With respect to claim 1, the claim recites “each advertisement generator including a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one item-specific visual element of an advertisement being created for the item, and a third algorithm for creating a link to information about the item.” According to the Office Action at page 3 alleges that “the specification does not teach each generator uses three different algorithms to create the advertisement set.” Further, the Office Action at page 3 alleges that “the specification...does not teach that the generator uses algorithm for determining creative aspect.” Applicants respectfully submit that the specification indeed supports the recited limitation.

Specifically, Applicants’ specification at page 4, paragraph 16, recites that “the different advertisement generators may use different algorithms to automatically generate (or ‘create’) advertisements (also referred to as the ‘creative’), identify search terms, and create links to form advertisement sets.” In addition, the same paragraph recites that, for example, “an advertisement generator may scan through a catalog of books that are being offered for sale by an advertiser and generate an advertisement set for a particular book that includes an advertisement based on the title of the book, search terms based on the words in the title, and a link to a detailed web page associated with the book.” Thus, Applicants’ specification recites that a single advertisement generator may “use different algorithms” to perform each of the aforementioned tasks recited in claim 1, namely, identifying search terms, determining at least one visual element, and creating a link. Thus, for at least this reason, Applicants respectfully submit that “each advertisement generator” including a first algorithm, second algorithm, and third algorithm, as recited in claim 1, is supported by the specification as filed.

As for the Office Action’s allegation that “the specification...does not teach that the generator uses algorithm for determining creative aspect,” Applicants note that the term “creative aspect” has been amended in claim 1 to recite a “item-specific visual element” in order to address the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, discussed more fully below. Nevertheless, regardless of the terminology used, Applicants respectfully point to

Figure 9 of the originally-filed application and corresponding text in paragraph 35 on page 15. Specifically, Applicants' specification recites a non-limiting example wherein "In block 905, the component retrieves a name from the record" and "if the item is a book, then the name may be the title of the book." Further, "in block 906, the component adds the name to the advertisement of the advertisement set." Thus, Applicants' specification supports an algorithm determining a creative aspect (or item-specific visual element) of an advertisement, such as a title of a book in the illustrative embodiment.

B. Dependent Claims 2, 4, and 6-8

The Office Action does not provide a reason for the rejection of claims 2, 4, and 6-8. Because these claims depend from claim 1, Applicants presume that these claims were rejected under 35 U.S.C. § 112, first paragraph for inheriting the allegedly problematic subject matter of claim 1. Because, as above, claim 1 is allowable under 35 U.S.C. § 112, first paragraph, Applicants respectfully submit that claims 2-4 and 6-8 are likewise allowable.

C. Independent Claim 9

Claim 9 is rejected under 35 U.S.C. § 112, first paragraph because, allegedly, "the specification however does not teach an algorithm specifying a creative aspect of an advertisement generated by the algorithm." While Applicants disagree with this statement, Applicants respectfully submit that claim 9 is allowable at least for reasons similar to those discussed above in connection with claim 1. In particular, Applicants have amended claim 9 to change "creative aspect" to "item-specific visual element," which is supported by Applicants' specification at least for reasons similar to those discussed above.

D. Dependent Claims 10-21

As with claims 2, 4, and 6-8, the Office Action does not give a reason for the rejection under 35 U.S.C. § 112, first paragraph of claims 10-21 and, therefore, it is presumed that the rejection is based on the claims' dependency to claim 9. Accordingly, Applicants

respectfully submit that the above-discussed amendment to claim 9 addresses any alleged issues with the claims under 35 U.S.C. § 112, first paragraph.

E. Independent Claim 35

Claim 35 is rejected under 35 U.S.C. § 112, first paragraph “for the same reason” as claim 9. While Applicants disagree with this statement, Applicants respectfully submit that claim 35 is allowable at least for reasons similar to those discussed above in connection with claim 1. In particular, Applicants have amended claim 35 to change “creative aspect” to “item-specific visual element,” which is supported by Applicants’ specification at least for reasons similar to those discussed above.

III. Claims 1, 2, 4, 6-14, 16-21, and 35 Comply with the Written Description Requirement of 35 U.S.C. § 112, Second Paragraph

A. Independent Claim 1

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph as allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Specifically, the Office Action on page 4 states “it is unclear what ‘at least one different advertisement’ means.” While Applicants disagree with the rejection, for the purpose of expediting prosecution, Applicants have amended claim 1 to change the term “different advertisement” to “associated advertisement” to clarify that the advertisement is associated with the advertisement set.

Claim 1 is also rejected under 35 U.S.C. § 112, second paragraph because, allegedly, “Applicants’ specification does not provide clear definition of a ‘creative aspect’” and “it is unclear what is considered a creative aspect of an advertisement.” As noted above, Applicants have amended claim 1 to recite an “item-specific visual element” in place of a “creative aspect.” This amendment clarifies that the creative aspect is an item-specific visual element for which the advertisement is being created. Applicants respectfully submit that this

amendment clarifies any alleged uncertainty in the claims and, therefore, that claim 1 is allowable under 35 U.S.C. § 112, second paragraph.

B. Dependent Claims 2, 4, and 6-8

The Office Action does not provide a reason for the rejection of claims 2, 4, and 6-8. Because these claims depend from claim 1, Applicants presume that these claims were rejected under 35 U.S.C. § 112, second paragraph for inheriting the allegedly problematic subject matter of claim 1. Because, as above, claim 1 is allowable under 35 U.S.C. § 112, second paragraph, Applicants respectfully submit that claims 2-4 and 6-8 are likewise allowable.

C. Independent Claim 9

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph because the claim recites “each advertisement set being generated for the same advertiser and the same keyword,” and allegedly, “there is insufficient antecedent basis for this limitation in the claim.” According to the Office Action at page 5, the claim does not recite “advertiser” or a “keyword.” Applicants have amended claim 9 to recite “a common advertiser” and “a common keyword,” therefore addressing any antecedent basis issues with claim 9.

Claim 9 is additionally rejected because “it is unclear if the automatically created advertisement is the same as the one generated by the advertisement generator (which is part of the advertisement set) or is in addition to the advertisement set.” While Applicants respectively disagree, Applicants have amended claim 9 to recite that “each advertisement set” includes the “respective at least one automatically created advertisement.” Applicants respectfully submit that this amendment clarifies any alleged confusion in the claim terminology.

Finally, claim 9 is rejected under 35 U.S.C. § 112, second paragraph because, allegedly, “the specification also does not disclose that the advertisement set includes a bid amount.” In order to expedite prosecution, Applicants have amended claim 9 to recite that “each advertisement set associated with a corresponding a bid amount.” Applicant submits that this amendment is supported by the specification in various places, such as in paragraph 20, which

recites that “the advertisement manager invokes a bid calculator 106 to calculate a bid amount for each advertisement set.” Therefore, Applicants respectfully submit that the aforementioned amendments address all alleged issues with claim 9

D. Dependent Claims 10-21

As with claims 2-4 and 6-8, the Office Action does not give a reason for the rejection under 35 U.S.C. § 112, second paragraph of claims 10-21 and, therefore, it is presumed that the rejection is based on the claims’ dependency to claim 9. Accordingly, Applicants respectfully submit that the above-discussed amendment to claim 9 addresses any alleged issues with the claims under 35 U.S.C. § 112, second paragraph.

E. Independent Claim 35

Claim 35 is rejected for the same reasons as claim 9. Accordingly, while Applicants do not necessarily agree with the reasons for the rejection under 35 U.S.C. § 112, second paragraph, for the purpose of expediting prosecution, Applicants have amended claim 35 in a manner similar to that discussed above with claim 9. Accordingly, Applicants respectfully submit that the above-discussed amendment to claim 35 addresses any alleged issues with the claim under 35 U.S.C. § 112, second paragraph.

IV. Claims 1, 2, 4, and 6-8 Are Allowable Under 35 U.S.C. § 103 Over Calabria et al.

Claims 1, 2, 4, and 6-8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Calabria et al. (US 2005/0137939).

With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not. M.P.E.P. § 2142. Accordingly, “the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”

M.P.E.P. § 2142; *see KSR International Co. v. Teleflex, Inc.*, 550 U.S.398, 82 USPQ 2d 1385, 1395-97 (2007).

A. Independent Claim 1

Applicants' claim 1 as amended recites a “computer system for requesting advertisements to be placed along with content on behalf of an advertiser in association with at least one keyword,” comprising:

- a plurality of advertisement generators each operable to automatically generate an advertisement set for the advertiser and the at least one keyword, each advertisement generator including a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one item-specific visual element of an advertisement being created for the item, and a third algorithm for creating a link to information about the item, each generated advertisement set including at least one associated advertisement created using the determined item-specific visual element, the link to information about the item, and at least one search term matching the at least one keyword;

- a fee calculator that calculates fee amounts for each of the advertisement sets generated by the advertisement generators based on anticipated profitability of the advertisement sets;

- an advertisement manager that:

- receives from the advertisement generators the generated advertisement sets,

- receives from the fee calculator a fee amount for each of the generated advertisement sets,

- determines whether an advertisement set is currently submitted to an advertisement placement service for the keyword, and

- when an advertisement set is not currently submitted to the advertisement placement service for the keyword, selects one of the generated advertisement sets for submission to the advertisement placement service; and

- an advertisement submitter that, when an advertisement set is not currently submitted to the advertisement placement service for the keyword:

- receives from the advertisement manager the selected

- advertisement set and the fee amount for the selected advertisement set, and

- sends to the advertisement placement service a request to place the selected advertisement set along with content associated with the keyword at the fee amount of the selected advertisement set.

Such limitations are neither taught nor suggested by Calabria.

For example, Calabria teaches a “server-based method of automatically generating a plurality of bids for an advertiser for placement of at least one advertisement in associated with a search results list” (paragraph [0021]). Calabria teaches “receiving at least one candidate advertisement from the advertiser” then “creating a list of candidate keywords” and “calculating a bid amount for each advertisement-keyword pair” (paragraph [0021]). Calabria teaches “an advertisement selection agent (54)” that “includes an algorithm for selection of an advertisement from the advertisement database (46) that is to be matched with a given keyword of keyword combination” (paragraphs [0052] and [0121]). Calabria uses “a bidding agent (50)” to “select a corresponding keyword advertisement” and determine a bid to be submitted (paragraph [0042]). Calabria thus is directed to selecting an advertisement from a set of advertisements, matching candidate keywords with the selected ad, and determining a bid price for the combination.

Calabria does not, however, teach or suggest “a plurality of advertisement generators” as recited in Applicants' claim 1 as amended, where each advertisement generator is “operable to automatically generate an advertisement set for the advertiser and the at least one keyword”. Calabria also does not teach or suggest that “each advertisement generator” includes “a first algorithm for identifying search terms corresponding to an item to be advertised, a second algorithm for determining at least one item-specific visual element of an advertisement being created for the item, and a third algorithm for creating a link to information about the item.” Calabria also does not teach or suggest that “each generated advertisement set” includes “at least one associated advertisement having the determined item-specific visual element, a link to information about the item, and at least one search term matching the at least one keyword.”

With respect to the element reciting “a plurality of advertisement generators,” the Office Action at page 6 alleges that this element is disclosed by Calabria at paragraphs 52-55 and 121. Applicants respectfully disagree. Paragraphs 52-55 are directed to various aspects of a “keyword advertisement management system 14” such as a “keyword selection agent 52,” an “advertisement selection agent 54,” a “ROAI agent 56,” and a “bidding agent 50.” None of the components of the keyword advertisement management system 14 described in paragraphs 52-55 are “advertisement generators” as recited in claim 1. As an example, Calabria's paragraph 52

describes that “the advertisement selection agent 54 includes an algorithm for selection of an advertisement from the advertisement database.” Thus, Calabria’s advertisement selection agent 54 performs “selection of an advertisement from the advertisement database” but does not “generate an advertisement set for the advertiser,” as recited in claim 1.

The other elements of the keyword advertisement management system 14 of Calabria described in paragraphs 52-55 and 121 similarly perform as their names indicate, which does not include “generat[ing] an advertisement set,” as recited in claim 1. As an example, paragraph 52 also describes that “the keyword selection agent 52 includes an algorithm for selection of keywords and keyword combinations that are included in the keyword database 48.” Again, nothing discloses, teaches, or suggests anything that is “operable to automatically generate an advertisement set for the advertiser,” as recited in claim 1. Accordingly, Applicant respectfully submits that Calabria does not disclose, teach, or suggest such subject matter as recited in claim 1 and, therefore, that claim 1 is allowable under 35 U.S.C. § 103 for at least this reason.

B. Dependent Claims 2, 4, and 6-8

Claims 2, 4, and 6-8 are allowable over the cited references at least in view of their dependency from claim 1 discussed above. Further, elements of at least some of these claims are also patentable over these references as these elements also are neither taught nor suggested by these references.

For example, claim 6 recites “multiple advertisement submitters where each advertisement submitter is associated with an advertisement placement service.” The Office Action at page 7 alleges that this element is taught at paragraph 153 of Calabria. Applicants respectfully disagree. Paragraph 153 is directed to “several aspects of the keyword advertisement management system.” One aspect described by Calabria is that “for advertisers that advertise on more than one PPC web site at a time, the keyword advertisement management system can handle multiple PPC web sites and optimize ROAI for the advertiser.” However, paragraph 153 of Calabria does not disclose, teach, or suggest that advertising “on more than one

PPC web site at a time” using multiple advertisement submitters, as recited in claim 6.

Therefore, Applicants respectfully submit that claim 6 is allowable under 35 U.S.C. § 103 over Calabria for at least this reason.

V. Claims 9-14, 16-21, and 35 Are Allowable Under 35 U.S.C. § 103 Over Calabria in View of Harik

Claims 9-14, 16-21, and 35 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Calabria in view of Harik (U.S. Pub. No. 2005/0065806). Applicants respectfully disagree.

A. Independent Claim 9

Applicants' claim 9 as amended recites, in part, a “method in a computer system for placing advertisements,” the method comprising:

automatically creating at least one advertisement for each of a plurality of advertisement sets being generated using a plurality of advertisement generators, each advertisement generator including a different algorithm for determining at least one item-specific visual element of the at least one advertisement being created for a respective advertisement set, each advertisement set being generated for a common advertiser and a common keyword, each advertisement set including the respective at least one automatically created advertisement and the keyword, and each advertisement set associated with a corresponding a bid amount;

For reasons including at least some of those discussed above, neither Calabria nor Harik, individually or in combination, teach or suggest each element of this claim. For example, for reasons similar to those discussed above, Calabria fails to teach or suggest “automatically creating at least one advertisement for each of a plurality of advertisement sets being generated using a plurality of advertisement generators” or “each advertisement generator including a different algorithm for determining at least one item-specific visual element of the at least one advertisement being created for a respective advertisement set” as recited in Applicants' amended claim 9. Harik does not make up for Calabria's failure to teach these elements. For instance, assuming *arguendo* the Office Action's statement that Harik teaches “automatically

creating at least one advertisement, each advertisement generator determines creative aspect of at least one advertisement,” Harik does not disclose, teach or suggest the “plurality of advertisement generators” that create “at least one advertisement for each of a plurality of advertisement sets,” as recited in claim 9. Thus, the proposed combination of Calabria and Harik does not teach or suggest each element recited in the claim. As such, Applicants' claim 9 cannot be rendered obvious by these references for at least these reasons.

B. Dependent Claims 10-14 and 16-21

Claims 10-14 and 16-21 depend from independent claim 9. Accordingly, Applicants respectfully submit that claims 10-14 and 16-21 are allowable at least for depending from an allowable base claim. In addition, Applicants respectfully submit that at least some of claims 10-14 and 16-21 additionally recite patentable subject matter not taught or otherwise rendered obvious by Calabria and Harik, individually or in combination.

For example, amended claim 13 recites “calculating the bid amount based on advertising metrics collected by the common advertiser.” The Office Action at page 8 alleges that Calabria teaches “calculating the bid amount based on advertising metrics” at paragraphs 35-40, 44-47, and 52-60, 109, and 121. With respect to bids, these paragraphs of Calabria describe, for example, that “the bidding agent 380 uses information received from the data collection process 377, historical data database 378, keyword and advertisement copy agent 381, and value per visitor calculator process 382 to determine bids for each keyword and advertisement combination.” Calabria, paragraph 109. Calabria does not disclose, teach, or suggest that the information used by the bidding agent 380 is “collected by the common advertiser,” as recited in claim 13. Harik does not make up for the failure of Calabria to disclose, teach, or suggest this element. Therefore, Applicants respectfully submit that claim 13 is allowable over Calabria in view of Harik.

As another example, claim 14 recites “the bid amount is adjusted based on the advertising metrics.” Claim 14 depends from claim 13 and, therefore, also specifies that the “advertising metrics [are] collected by the common advertiser.” Consequently, for reasons

similar to those discussed above, Applicants respectfully submit that Calabria and Harik do not, either individually or in combination, disclose, teach, or suggest this element. Therefore, Applicants respectfully submit that claim 14 is allowable at least for this additional reason.

C. Independent Claim 35

As amended, Claim 35 recites, in part, “a computer program product embedded in a computer-readable medium” that includes:

program code for automatically creating at least one advertisement for each of a plurality of advertisement sets being generated using a plurality of advertisement generators, each advertisement generator including a different algorithm for determining at least one item-specific visual element of the at least one advertisement being created for a respective advertisement set, each advertisement set being generated for a common advertiser and a common keyword, each advertisement set including the respective at least one automatically created advertisement and the keyword, and each advertisement set associated with a corresponding a bid amount.

Therefore, at least for reasons similar to those discussed above, Applicants respectfully submit that Calabria and Harik do not, either individually or in combination, disclose, teach, or suggest such subject matter as recited in claim 35. Accordingly, Applicants respectfully submit that claim 35 is allowable under 35 U.S.C. § 103 over Calabria in view of Harik.

VI. Amendment To The Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, Applicants do not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by

another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that Applicants have made any disclaimers or disavowals of any subject matter supported by the present disclosure.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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